

REMARKS

Applicants respectfully request reconsideration of the present Application. Claims 1-6, 16, 22, 26, and 32 have been amended herein. Care has been exercised to introduce no new matter, Claims 1-46 are pending and are in condition for allowance.

Rejections based on 35 U.S.C. § 101

Claims 1-25 and 32-46 were rejected under 35 U.S.C. § 101 because the Office Action held that the claimed invention is directed to non-statutory subject matter. More specifically, claims 1-25 and 32-46 were rejected for being drawn merely to the production and/or manipulation of non-functional descriptive material, effecting no “useful, concrete, and tangible result.” Claims 1-25 and 32-46 were further rejected because they fail to satisfy the requirements for statutory subject matter eligibility because they were considered to preempt the underlying abstract idea, since they would foreclose others from substantially all practical applications of the same abstract idea.

Independent claim 1 has been amended to recite “[a] method for displaying on a screen an optimized placement of search result listings displayed in a Web page....” Amended independent claim 1 is directed to a useful, concrete, and tangible result, which comprises statutory subject matter. As amended, independent claim 1 is directed to displays on a computer display screen. As such, Applicants respectfully submit that amendments overcome the § 101 rejection of independent claim 1.

Claims 2-15 depend either directly, or indirectly, from independent claim 1, as such claims 2-15 were rejected as incorporating the deficiencies of independent claim 1. It is respectfully submitted that the amendments to independent claim 1 and the resulting dependency of claims 2-15 overcome the § 101 rejection thereof.

Independent claim 16 has been amended to recite “[o]ne or more computer-accessible media having instructions for performing a search results optimization system....” Independent claim 16 is directed to a useful, concrete, and tangible result, which comprises statutory subject matter. Additionally, independent claim 16 is directed to computer-accessible media. As such, Applicants respectfully submit that the amendments overcome the § 101 rejection of independent claim 16.

Claims 17-25 depend either directly, or indirectly, from independent claim 16, as such claims 17-25 were rejected as incorporating the deficiencies of independent claim 16. It is respectfully submitted that the amendments to independent claim 16 and the resulting dependency of claims 17-25 overcome the § 101 rejection thereof.

Independent claim 32 has been amended to recite “[o]ne or more computer-accessible media having instructions for performing a method for displaying on a display device a search result Web page....” Independent claim 32 is directed to a useful, concrete, and tangible result, which comprises statutory subject matter. As amended, independent claim 32 is directed to computer-accessible media. As such, Applicants respectfully submit that the amendments overcome the § 101 rejection of independent claim 32.

Claims 33-46 depend either directly, or indirectly, from independent claim 32, as such claims 33-46 were rejected as incorporating the deficiencies of independent claim 32. It is respectfully submitted that the amendments to independent claim 32 and the resulting dependency of claims 33-46 overcome the § 101 rejection thereof.

As such, the withdrawal of the 35 U.S.C. § 101 rejection of claims 1-25 and 32-46 is respectfully requested.

Rejections based on 35 U.S.C. § 112

Claims 1-46 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More precisely, the Office Action states that the terms “actual performance” and “expected performance” are not clearly defined, thus it is unclear what is being claimed. Applicants have amended independent claims 1, 16 and 32 to more precisely recite an actual performance comprising at least one of the actual click-through rate and the context of the listing and an expected performance comprising a user defined, adjusted click-through rate. Applicants further submit that independent claim 26 as originally presented does not disclose an actual performance nor an expected performance, but rather discloses an actual click-through rate and an expected click-through rate. Therefore, independent claim 26 should not be subject to rejection for indefiniteness based on the “actual performance” and “expected performance” language. As such, Applicants respectfully submit that the amendments and clarification overcome the 35 U.S.C. § 112, second paragraph, rejection to independent claims 1, 16, 26 and 32, as such, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, second paragraph, rejection to claims 1, 16, 26 and 32.

Claims 2-15, 17-25, 27-31 and 33-46 depend directly or indirectly from independent claims 1, 16, 26 and 32. As such, each of dependent claims 2-15, 17-25, 27-31 and 33-46 incorporates the subject matter of amended independent claims 1, 16 and 32 or clarified independent claim 26. *See*, 37 C.F.R. 1.75(c). Accordingly, it is respectfully requested that the 35 U.S.C. § 112 rejection of dependent claims 2-15, 17-25, 27-31 and 33-46 be withdrawn at least by virtue of their dependency.

In further support of the rejection the Office Action states that the term “prominently” in each of claims 2-6 is a relative term which renders the claims indefinite. Claims 2-6 have been amended to more clearly recite “more prominent” locations and “less prominent” locations as such language was not objected to in independent claim 16. Accordingly, Applicants believe claims 2-6 are in condition for allowance and it is respectfully requested that the 35 U.S.C. § 112 rejection of claims 2-6 be withdrawn.

Additionally, the Office Action states that claim 22 recites insufficient antecedent basis for the limitation “the performance settings repository” in lines 1 and 2. Applicants have amended claim 22 to provide sufficient antecedent basis for “a performance settings repository.” As such, Applicants believe claim 22 to be in condition for allowance and it is respectfully requested that the 35 U.S.C. § 112 rejection of claim 22 be withdrawn.

Rejections based on 35 U.S.C. § 102(e)

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggall Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 19133, 1920 (Fed. Cir. 1989); *see also*, MPEP § 2131.

Claims 1-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kamangar et al., U.S. Publication No. 2003/0046161 (hereinafter “Kamangar”). As Kamangar does not describe, either expressly or inherently, each and every element of the rejected claims, applicants respectfully traverse the rejection as hereinafter set forth.

As currently amended independent claims 1 and 32 disclose a method for displaying on a screen an optimized placement of search result listings displayed in a search Web page. The method comprises the steps of first, measuring an actual performance of a listing located in a Web page containing a search term and a search result corresponding to the search term, wherein the actual performance comprises at least one of click-through rate (CTR) and context of the listing and second, assigning an expected performance for the listing based on the location, wherein the expected performance comprises at least one of a user defined expected CTR and the context of the listing. The method further comprises the steps including comparing the actual performance to the expected performance for the listing and promoting the listing to a more prominent location when the actual performance is better than the expected performance or demoting the listing to a less prominent location when the actual performance is poorer than the expected performance. Thus, by the disclosed method of independent claims 1 and 32 the promotion or demotion of listings is based on a comparison of an individual listings expected performance and its actual performance.

In contrast, Kamangar discloses an advertising system which orders ads in a manner that maximizes both their relevance and economic values based on ad price information and performance information. *Kamangar* at [0012]. Such performance information is based on one or more measures of interest in the advertisement such as click-through rate, user ratings of the ad, focus group ratings, or an interest measurement that is weighted for such factors as size of the ad, or placement of the ad on the page, among others. *Id.* at [0014] and [0040]. To order the advertisements on a page a list of candidate ads is obtained and one or more performance parameters are identified. *Id.* A score is then obtained for each of the listed ads based on the performance information corresponding to the identified performance parameters. *Id.* at [0040]

and [0043]. Finally, the ads are ordered based on their scores and such order is utilized to determine placement of the ads on a page. *Id.* at [0043], [0049] and Figs. 3 and 6.

As such, Kamangar is the opposite of Applicants' claimed invention. Kamangar's teachings compare the score of one ad to those of others within a selected list of ads in order to determine an ordering of those listed ads with respect to one another and subsequently to determine their placement on a page. Conversely, Applicants teach comparing the actual performance data and expected performance data of a single ad and utilizing that comparison to determine changes in the ad's placement on a page. Thus, the movement, i.e. promotion or demotion, of an ad following the Applicants' method is determined solely by the ad's own performance and expected performance, whereas the movement of an ad under Kamangar is determined based on the comparison of the ad's performance to that of other listed ads.

Accordingly, it is respectfully submitted that Kamangar fails to describe, either expressly or inherently, each and every element of independent claims 1 and 32. Thus, it is respectfully submitted that independent claims 1 and 32, as amended herein, are not anticipated by Kamangar. Therefore, withdrawal of the 35 U.S.C. § 102 rejection of claims 1 and 32 is respectfully requested.

Each of claims 2-15 and 33-46 depends either directly or indirectly, from amended independent claims 1 and 32. As such, it is respectfully submitted that Kamangar fails to describe, either expressly or inherently, each and every element of these claims for at least the above-cited reasons. Accordingly, withdrawal of the 35 U.S.C. § 102 rejection of claims 2-15 and 33-46 is respectfully requested.

Additionally, with respect to the Office Action's rejection of claims 13 and 44, Kamangar fails to describe the claimed matter. Claims 13 and 44 disclose the above described

methods of independent claims 1 and 32 wherein the “performance of a listing is based on an overall performance of a set of listings to which the listing belongs, and promoting and demoting the listing includes promoting and demoting the set of listings based on the overall performance.” In support of this rejection the Office Action cites to Kamangar at [0043] wherein Kamangar discloses a group of four ads that are ordered based on their scores. Although, this may disclose ordering a group, or set (where “set” is used as a synonym for group) of ads, Kamangar’s disclosure is distinctly different from that of Applicants. The “set” of Applicants’ claims comprises a group of listings that have an overall expected performance and an overall actual performance which are utilized to determine if the *set* of listings is to be moved. *Applicants’ Specification* at p. 13 line 21-27. Typically only one ad from such a set might be displayed at a time and a different member of the set is chosen and displayed sequentially or randomly each time the page is loaded, navigated to, or refreshed, among others. Further, where it is determined that the set should be moved all of the listings in the set are either promoted together or demoted together as a set. *Id.* This contrasts the group in Kamangar in which each ad is singularly moved in relation to the other ads in the group, i.e. each ad is promoted or demoted individually.

Accordingly, it is respectfully submitted that Kamangar fails to describe, either expressly or inherently, each and every element of claims 13 and 44 for at least the above stated reasons as well as because of their dependency on independent claims 1 and 32. Thus, it is respectfully submitted that claims 13 and 44, are not anticipated by Kamangar. Therefore, withdrawal of the 35 U.S.C. § 102 rejection of claims 13 and 44 is respectfully requested.

With respect to independent claim 16 the Office Action cites to Kamangar at [0014-0043]. As stated above, the cited portions of Kamangar disclose ordering a list of

advertisements based on scores obtained for each ad based on their performance information. *Kamangar* at [0040]. Independent claim 16, as amended recites one or more computer-accessible media having instructions for performing a search results optimization system. Said system comprises a performance measurement process to measure an actual performance of a listing appearing in a search results Web page against an expected performance level, wherein the actual performance comprises at least one of click-through rate and context of the listing and where the expected performance level comprises a user defined expected click-through rate that is adjusted based on whether the listing appears in a more prominent or less prominent location. The system further comprising a listing placement process to promote the listing to the more prominent location when the actual performance measures higher than the expected performance level, and to demote the listing to the less prominent location when the actual performance measures lower than the expected performance level.

As stated previously and for at least the same reasons, *Kamangar* is opposite of Applicants' claimed invention. *Kamangar* teaches comparing a score of one ad to those of others within a selected list of ads in order to determine an ordering of those listed ads with respect to one another and thereby determine the placement of those ads on a page. Conversely, Applicants teach comparing the expected performance data and actual data of a single ad and utilizing that comparison to determine changes in the ad's placement on a page. Thus, the movement, i.e. promotion or demotion, of an ad following the Applicants' method is determined solely by the ad's own performance, whereas the movement of an ad under *Kamangar* is determined based on the comparison of the ad's performance to that of other listed ads.

Accordingly, it is respectfully submitted that *Kamangar* fails to describe, either expressly or inherently, each and every element of independent claim 16. Thus, it is respectfully

submitted that independent claim 16, as amended herein, is not anticipated by Kamangar. Therefore, withdrawal of the 35 U.S.C. § 102 rejection of claim 16 is respectfully requested.

Each of claims 17-25 depends either directly or indirectly, from amended independent claim 16. As such, it is respectfully submitted that Kamangar fails to describe, either expressly or inherently, each and every element of these claims for at least the above-cited reasons. Accordingly, withdrawal of the 35 U.S.C. § 102 rejection of claims 17-25 is respectfully requested.

With respect to independent claim 26, the Office Action cites to Kamangar at [0043] in support of the rejection of the first element of the claim. The first element of independent claim 26 recites “placing a listing for a search result in an initial location based on an expected click-through rate...” The referenced portion of Kamangar, nor the remainder thereof, does not disclose placing an ad in any position based on an expected click-through rate alone. The referenced portion only discloses ordering ads relative to one another based on scores derived from performance information.

Kamangar is also cited at paragraphs [0040], [0043], [0048] and Fig. 3 in support of the rejection of the remaining portions of independent claim 26. As stated previously for independent claims 1, 16, and 32, the cited portions of Kamangar disclose determining a score based on performance information for each of a group of ads and using that score to order the ads with respect to one another. In contrast, independent claim 26 teaches an expected click-through rate and an actual click-through rate for a single listing, which are compared to determine if the listing should be promoted or demoted. Thus, the listing disclosed by Applicants is moved based on its own performance whereas the listings of Kamangar are moved based on the relationship of their score with respect to that of the other listings in the group.

Accordingly, it is respectfully submitted that Kamangar fails to describe, either expressly or inherently, each and every element of independent claim 26. Thus, it is respectfully submitted that independent claim 26, as amended herein, is not anticipated by Kamangar. Therefore, withdrawal of the 35 U.S.C. § 102 rejection of claim 26 is respectfully requested.

Each of claims 27-31 depends either directly or indirectly, from independent claim 26. As such, it is respectfully submitted that Kamangar fails to describe, either expressly or inherently, each and every element of these claims for at least the above-cited reasons. Accordingly, withdrawal of the 35 U.S.C. § 102 rejection of claims 27-31 is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-46 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or areed@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

/Aaron S. Reed/

Aaron S. Reed
Reg. No. 56,116

ASR/bp
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550